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54

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,815	04/13/2001	Shinobu Hasegawa	Q64020	5723

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

17

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,815

Applicant(s)

HASEGAWA ET AL.

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiki et al. (4,301,725) in view of Bresson (5,205,213)

Hiki et al. teach a roller member comprising a metallic core roller **16** (The hash lines in fig. 3 show that the core is metal. See also MPEP 608.02), and a substantially unshrinkable sleeve **44** which is heat-welded (col. 3, lines 13-14) directly onto the surface of the core roller **16** into which the substantially unshrinkable sleeve **44** is pressed, wherein the substantially unshrinkable sleeve **44** is formed of an elastomer material and has a Young's modulus of 120-200 MPa (The sleeve **44** is made of "polyamide resin sleeve", col. 3, line 4, which is the same material that applicant uses, see page 4, line 22-23 of applicant's specification. Therefore, it is inherent that the sleeve has the claimed Young's modulus). Regarding the limitations "is used for OA apparatuses for imparting a charge, eliminating a charge, or removing toner adhered onto the surface of a transfer belt or a transfer-conveyor belt", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

Art Unit: 3726

claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Hiki et al. teach the invention cited with the exception of the thickness of the sleeve being 30-200 micrometer.

Bresson teaches that it is known to make sleeves with a thickness of 30-200 micrometer (col. 2, lines 25-46).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hiki et al. with a sleeve thickness of 30-200 micrometer, in light of the teachings of Bresson, in order to provide a sleeve thickness that creates a light weight roll.

Regarding claim 2, Hiki et al. teach that the substantially unshrinkable sleeve **44** is formed from polyamides (col. 3, line 5).

Regarding claim 3, the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Regarding claim 4, Hiki et al. teach the same sleeve material that applicant uses, therefore, Hiki et al. inherently teach the claimed surface resistivity.

3. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiki et al. in view of Bresson as applied to claim 1 above, and further in view of Lane et al. (5,983,799).

Hiki et al./Bresson teach the invention cited, in the rejection of claim above, with the exception of the sleeve having a surface roughness of 5 micrometer or less.

Lane et al. teach a surface roughness that can be 5 micrometer or less (col. 6, lines 13-14).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hiki et al./Bresson with the sleeve having a surface roughness of 5 micrometer or less, in light of the teachings of Lane et al., in order to provide a sleeve that is capable of meeting tolerance requirements as suggested by Lane et al. at col. 6, lines 15-16.

4. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiki et al. in view of Bresson as applied to claim 1 above, and further in view of White et al. (4,089,265).

Hiki et al./Bresson teach the invention cited, in the rejection of claim 1 above, with the exception of the sleeve having an inner diameter smaller than the outer diameter of the core roller.

White et al. teach a sleeve **17** having an inner diameter smaller than the outer diameter of the core roller **11**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention,

Art Unit: 3726

to have provided the invention of Hiki et al./Bresson with the sleeve having an inner diameter smaller than the outer diameter of the core roller, in light of the teachings of White et al., in order to provide an even tighter fitting sleeve.

Response to Arguments

5. Applicant's arguments with respect to claims 1-5 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

7. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

Art Unit: 3726

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/

MJ

February 9, 2004

J. C. R.
Am 3726